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Eugene S. Smotkin

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Eugene Smotkin

Appeal 2009-011268
Application 09/891,200
Technology Center 1700

Oral Hearing Held: Wednesday, January 13, 2010

Before JEFFREY T. SMITH, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

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1 *The above-entitled matter came on for hearing on Wednesday,*
2 *January 13, 2010, commencing at 10:55 a.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, Alexandria, Virginia, before*
4 *Ashorethea Cleveland, Notary Public.*

5 JUDGE SMITH: Okay. After you get settled in, you will have
6 20 minutes to present your arguments and you can begin when you're ready.

7 MS. MURASHIGE: Okay. Thank you, so much; and I hope
8 I'm not trying your patience. I know that I'm the last person after a very long
9 morning for you all. So, I really appreciate it.

10 I think the briefs do summarize where we stand and where the
11 Examiner stands pretty well, and my main purpose in coming, as you
12 probably understand, is that I would like to have you give some feedback, if
13 you would, on what your concerns are.

14 But just to start out: I guess both the Examiner and we are
15 pretty much at an impasse, and we've all accused each other of repeating
16 arguments and so forth which is all true.

17 The other thing that we seem to agree on, oddly enough, is that
18 there is an invention here; and the reason I say that is that on page 35 of the
19 Examiner's Answer he says that he might side with us if Appellant were
20 claiming a fuel cell unit comprising a first electrode, a second electrode and
21 the specifically claimed proton-conducting membrane. "In this particular
22 case and in the context of a well defined fuel cell structure, appellant might
23 perhaps be right. However, in the context of the appellant's invention, the
24 claim subject matter is merely a metal or metal hydride support having a

1 coating material deposited thereon."

2 And so, what I'm thinking is, you know, if he thinks that this
3 foil with the deposit would be patentable if you just put it in its intended
4 art-known context -- if it's patentable then, I'm having trouble seeing why it
5 isn't patentable as claimed, and I'm wondering if I'm missing something
6 there.

7 JUDGE SMITH: Unfortunately, we just look at the record
8 that's presented before us. It's not our position actually to step into the
9 Examiner's shoes and try to interpret exactly what he's thinking when he
10 says that something might be patentable incorporated into a fuel cell. We
11 really aren't in the position to speak to that specific issue.

12 MS. MURASHIGE: Well, I guess why I'm saying that is that
13 it's been apparent throughout that, you know, it's been troubling him and
14 perhaps it's troubling you that what we're claiming is not a complex piece of
15 apparatus but a fairly straight- forward article of manufacturer, and I don't
16 know of any law that says that because the article of manufacturer doesn't
17 have a lot of bells and whistles that it's therefore not patentable if it's not
18 suggested by the art.

19 I'd kind of like to emphasize that aspect of it because it seems a
20 little unfair to say, well, just because it's only a piece of metal with a deposit
21 on it therefore it must be unpatentable, and that seems to be where he's
22 coming from.

23 Then dealing with the specific rejections that he has put
24 forward, I'm also puzzled by the alleged anticipation over Baucke where he

1 is saying that this reads on the invention because they constitute a metal
2 support and a coating layer when the claim specifically requires only a
3 single foil and not two, and I know you have these before you. If I can. Do
4 you mind?

5 JUDGE SMITH: That's fine.

6 MISS MURASHIGE: He's pointing to figure two and saying
7 that that anticipates when the claim clearly states that there is only a single
8 foil; and as you can see, there are two metal foils which bracket the
9 electrolyte in that case.

10 So, there's just a limitation in the claim that Baucke doesn't
11 meet.

12 I don't know whether there's a further concern about Baucke.
13 Baucke's upper limit apparently is 140 degrees C and our apparatus is
14 assigned to operate at a much higher temperature. So, whatever problem
15 Baucke might be solving is not our problem. Are there any questions that
16 you might have about that?

17 JUDGE GAUDETTE: Were you attempting to distinguish your
18 claim on the basis of the temperature?

19 MS. MURASHIGE: No; not really. The real basis for
20 distinction is that there are two metal foils and the claim requires only a
21 single metal foil.

22 When we looked at Baucke, which I think surfaced in the
23 European prosecution, we felt, well, maybe there's kind of an accidental
24 anticipation here because there is a thin electrolyte but it's sandwiched

1 between two electrodes, not on a support foil.

2 JUDGE GAUDETTE: Is there a definition for "membrane" in
3 your specification?

4 MS. MURASHIGE: Yes. You mean the support?

5 JUDGE GAUDETTE: Well, your claim 75 recites a
6 proton-conducting membrane and I wondered if there was a definition of
7 what a proton-conducting membrane was.

8 MS. MURASHIGE: I'm not sure that there is in those terms
9 other than the way it's defined in the claim. I'm not sure that it says, a
10 membrane is this. The claim itself defines it as what's shown in
11 figure -- I'm looking at page 25, where it describes a membrane, electrolyte
12 assembly, and then figure three to which that refers shows the membrane in
13 the center as it is put into the actual fuel cell. But the membrane itself is as
14 defined in the claim as being a support with this inorganic material, and
15 that's described in considerable detail, really throughout the spec, and it's
16 exemplified in the example and shown in figure eight. It's the membrane that
17 supports the inorganic, non-liquid material.

18 JUDGE GAUDETTE: Okay.

19 MS. MURASHIGE: So, as I said, the Baucke document, if it
20 had only a single membrane might accidentally support, might accidentally
21 anticipate the claim, and we specifically limited it to a single membrane to
22 avoid that. But it's concerned with something else. It's concerned with
23 putting two electrodes, bracketing an electrolyte, non-support for the
24 electrolyte. So, that's Baucke.

1 And then the remaining rejections: There's a primary document
2 in each case and the 777 application, and then a number of secondary
3 documents which apparently -- although it isn't clear just the way it's written
4 but since it's only -- it's only the claims that include specific substances that
5 are disclosed in these documents that bring in the claims where those
6 substances are described.

7 Apparently, these are cited to show that there exists in the art
8 inorganic materials that are thought to be desirable as electrolytes, and we
9 know that and Norby specifically says that, and essentially the intent as I
10 hope has been clear is to overcome the problems that Norby has realized,
11 that there's a gap in the temperature range where there are inorganic
12 materials of suitable conductivity that would allow you to construct a fuel
13 cell in a traditional way. So, that is a problem that the invention is
14 attempting to solve.

15 So, in attempting to solve this problem without a suggestion
16 from the art -- and there doesn't appear to be any suggestion in the art that
17 -- the problem here is that if you try to make these things thin enough so that
18 their area of specific resistance is satisfactory, they simply crumble and you
19 can't do it and therefore you have to put them on this support membrane, and
20 that problem just never was addressed.

21 The other materials that are suggested in the secondary
22 references never come to fruition in terms of being able to put them into a
23 fuel cell; and the primary references, while they suggest membranes in the
24 middle of electrolytes are there for barrier purposes, not to support a

1 crumbling, otherwise satisfactory electrolyte. So, that's really the basis for
2 the invention.

3 We aren't finding in the art anything that suggests that you
4 could solve the problem of being able to operate these cells at the desirable
5 high temperatures by making the inorganic materials which you have to
6 use -- otherwise they would fall apart at high temperatures -- thin enough
7 and supportable enough to actually use.

8 JUDGE GAUDETTE: I have a question. The Examiner -- and
9 it's in response to your Appeal Brief. Page 43 of the Answer seems to be
10 interpreting or it says that he is interpreting the claim differently than you in
11 that he's saying, "The claim language broadly encompasses any inorganic
12 material regardless of its state, liquid, solid, gas or plasma." Was that point
13 ever discussed with the Examiner because it appears that you are arguing
14 that the claims require a liquid phase.

15 MS. MURASHIGE: No. The claim actually excludes the
16 liquid phase.

17 JUDGE GAUDETTE: I'm sorry. Excludes the liquid phase.

18 MS. MURASHIGE: Yes. I don't know why he said that. I
19 mean, the claim is pretty explicit that it can't have a liquid phase and if it did
20 it wouldn't work.

21 JUDGE GAUDETTE: I just saw that in the response and did
22 not see that you had mentioned it in the reply or that it was previously
23 discussed.

24 MS. MURASHIGE: You know, I guess I just apologize. I

1 guess I passed it over. But certainly, there is no inclusion in the claim of
2 anything that has any liquid in it and which I think shoots down, in my
3 opinion, shoots down the primary references because they are essentially
4 barriers for passages of what amounts to liquid, methanol in the case of the
5 777 and acid and base in the case of Smotkin.

6 So, I'm sorry. I think I just overlooked that in the Reply Brief. And I
7 don't know since the Examiner's Answer was exactly the same as the final
8 rejection. I probably should have paid more attention. I thought it was the
9 same thing I'd seen before.

10 JUDGE SMITH: Any more questions?

11 JUDGE GAUDETTE: No.

12 MS. MURASHIGE: Is my 20 minutes up?

13 JUDGE SMITH: Do you have anything else you would like to
14 add?

15 MS. MURASHIGE: I just wanted to add one thing that's not
16 relevant to the overall thing. It's the claim 84 and the question of the
17 trademark and the figure.

18 JUDGE SMITH: Okay.

19 MS. MURASHIGE: And I guess I just wanted to ask if -- I
20 mean, I think it conforms with the rules. It doesn't refer to
21 something that's not in the claim and the trademark is just identifying a
22 place in the figure. It could be called "Peter." You know, it doesn't matter
23 what it is. It's just what this is on the chart. So, I just wanted to reinforce
24 that.

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Application 09/891200

1 That 20 minutes went fast.

2 JUDGE SMITH: Okay.

3 JUDGE GAUDETTE: Okay. Thank you.

4 JUDGE SMITH: Thank you for coming in. We will consider
5 all your arguments as presented both here and principally on the record, and
6 the briefs. With nothing else, your case is submitted to the record. So, we
7 can go off the record.

8 Whereupon, at approximately 11:13 a.m., the proceedings were
9 concluded.

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